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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,265	10/22/2003	Jesse D. Crum	WK/2003-11/US	5446

7590 STEPHANIE HAY P.O. BOX 938 2401 COOPER STREET FORT SCOTT, KS 66701	08/10/2007
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EXAMINER	
BERNATZ, KEVIN M	

ART UNIT	PAPER NUMBER
1773	

MAIL DATE	DELIVERY MODE
08/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/691,265

Applicant(s)

CRUM, JESSE D.

Examiner

Kevin M. Bernatz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-22 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-10, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

DETAILED ACTION

Response to Amendment

1. Amendments to claims 2, 3, 5, 7 and 9, cancellation of claim 1, and addition of new claims 21 and 22, filed on March 9, 2007, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

3. The new Figure 4 is accepted for entry in the above identified application.

Claim Objections

4. Claim 21 is objected to because of the following informalities: "mental" on line 2 should be "metal". Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "similar to" in claim 21 is a relative term which renders the claim indefinite. The term "similar to" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For the purposes of evaluating the prior art, the Examiner has interpreted the scope of "similar to" in the same manner as "about equal to". This rejection can be overcome by either replacing the term "similar" with "equal" or by acknowledging on the record agreement with the interpretation of the scope of the term given by the Examiner (i.e. interpreting "similar to" as equivalent to "about equal to").

Claim Rejections - 35 USC § 103

7. Claims 2 – 6, 9, 10, 21 and 22 are rejected under 35 U.S.C. 103(a) as obvious over Dahl, Jr. (U.S. Patent No. 3,455,770) in view of the general knowledge in the art as exemplified by Boudouris et al. (U.S. Patent No. 7,128,798 B2), Johnson (U.S. Patent No. 5,983,537), Burkholter (U.S. Patent No. 3,634,797), and/or Crum et al. (U.S. Patent App. No. 2003/0049403 A1).

Dahl, Jr. is relied upon for the reasons of record as set forth in Paragraph No. 4 of the Office Action mailed on December 11, 2006.

Regarding claim 21, Dahl, Jr. discloses a business document (*col. 1, lines 14 – 20*) comprising a magnetic portion (*Title and col. 4, lines 5 – 20*), comprising an elongated substrate adapted to be longitudinally imprinted (*Figure 15, element 82a and relevant disclosure thereto*), a substantially planar magnetic element (*element 88a and*

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relevant disclosure thereto) extending transversely of said substrate and so magnetized (*i.e. comprising a magnetic portion*), said magnetic element being of a thickness about equal (*i.e. similar*) to that of the substrate (*col. 4, lines 5 – 69*) and being positioned to substantially abut against a longitudinal end thereof (*Figure 15*), and a layer or printable material (*element 76a and relevant disclosure thereto*) overlying both said substrate and said magnetic element and being adhesively bonded thereto to connect them together (*col. 4, lines 5 – 69*).

Regarding the limitation(s) “non-impact printable” in line 1, the Examiner notes that this limitation(s) preamble limitation(s) which do(es) not set forth any structure, but merely state(s) the purpose or intended use of the invention. As stated in the MPEP, “if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, ***then the preamble is not considered a limitation and is of no significance to claim construction.*** *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) (“where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation”)” (MPEP 2111.02 – emphasis added). In the instant case, the Examiner notes that the index cards disclosed by Dahl Jr. are designed to be printed in high speed printers, therefor the Examiner deems that the disclosed invention meets the claimed preamble

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limitations as well as the intended use limitation "by a non-impact printer" on lines 3 – 4. Furthermore, the Examiner notes that the thickness of the magnetic layer is thinner than that which the prior art recognizes as suitable for non-impact printers (see *Crum et al.*, *Paragraph 0031*).

Dahl Jr. fail to discloses a document "magnetically attachable to a metal surface" and comprising a magnetic element "so magnetized to magnetically adhere to a metal surface".

However, even in the event that the invention as disclosed by Dahl Jr. fails to meet the claimed limitation, the Examiner notes that one of ordinary skill in the art would readily appreciate that the strength of a magnetic can be optimized depending on the desired end use. Specifically, the Examiner points to *Crum et al.* (*entire disclosure*), *Boudouris et al.* (*col. 1 line 12 bridging col. 2, line 31; col. 8, lines 38 – 49; col. 9, line 19 bridging col. 10, line 42; and col. 11, line 11 bridging col. 14, line 31*), *Burkholter* (*entire reference*) and *Johnson* (*col. 1, lines 56 – 62; col. 2, lines 54 – 61; col. 4, lines 55 – 64; and col. 5, lines 22 – 31*). Specifically, the prior art recognizes forming printable business cards including magnetic material for data storage/separation of the cards (*i.e. Dahl, Jr.*), as well as printable business cards using magnetic layers of the same order of magnitude as disclosed in Dahl Jr. for forming business cards attachable to metal surfaces (*above art, especially Boudouris et al. and Crum et al.*). The substitution of the magnetic material used by Dahl, Jr. with a permanent magnetic attachable to metal surfaces would not have resulting in any change of function to the attachable magnet, and the combined results would have been predictable to one of ordinary skill in the art

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given the similarity in thickness requirements between the two types of magnetic materials.

Therefore, the Examiner deems that it would have been obvious to utilize a magnetic film of sufficient strength (and/or reduce the weight of the paper to be attached; and/or increase the amount of the magnetic element included in the printed document) in order to form a document that was both printable and able to be adhered to metal surfaces.

Regarding new claim 22, the Examiner notes that Dahl, Jr. disclose that the thickness of the magnetic element "is generally equal" to the thickness of the non-magnetic portion (*col. 4, lines 50 – 69*), which is deemed to allow flexibility in the overall thickness of the magnetic portion versus the non-magnetic "substrate". As such, the relative thickness of the two layers can be permitted to be slightly thinner or thicker and still fall within the scope of the disclosed invention without materially affecting the use or function. Furthermore, the Examiner notes that the opposite face meets the claimed limitations (*Figure 15, element 78a and relevant disclosure thereto*).

Regarding claims 2 – 6, 9 and 10, Dahl, Jr. is relied upon for the reasons of record as described in Paragraph 4 of the Office Action mailed on December 11, 2006.

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8. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahl, Jr. in view of the general knowledge in the art as exemplified by Boudouris et al. (U.S. Patent No. 7,128,798 B2), Johnson (U.S. Patent No. 5,983,537), Burkholter (U.S. Patent No. 3,634,797), and/or Crum et al. (U.S. Patent App. No. 2003/0049403 A1) as applied above, and further in view of Kishimoto et al. (U.S. Patent No. 5,648,160).

Dahl Jr., Boudouris et al. Johnson, Burkholter and Crum et al. are relied upon as described above.

Kishimoto et al. is relied upon for the reasons of record as set forth in Paragraph No. 7 of the Office Action mailed on December 11, 2006. See also Boudouris et al., which teaches a high concentration of the magnetic powder in order to achieve suitable magnetic attraction to adhere to metal surfaces with extremely thin magnetic layers (*same citations as noted above*).

Response to Arguments

9. **The rejection of claims 2 – 10, 21 and 22 under 35 U.S.C § 102(b) and/or 103(a) – Various references**

Applicant(s) arguments have been considered but are moot in view of the new ground(s) of rejection

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

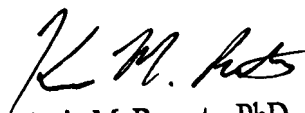
11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kevin M. Bernatz whose telephone number is (571) 272-1505. The Examiner can normally be reached on M-F, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB
August 7, 2007


Kevin M. Bernatz, PhD
Primary Examiner